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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,182	07/21/2006	Markus Dierker	C 2647 PCT/US	2215

23657 7590 03/18/2009

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EXAMINER	
GULLEDGE, BRIAN M	
ART UNIT	PAPER NUMBER
1619	
MAIL DATE	DELIVERY MODE
03/18/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/553,182	DIERKER ET AL.	
	Examiner	Art Unit	
	Brian Gulledge	1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/13/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of the species "unsaturated monofunctional alcohols and branched monofunctional alcohols" in the reply filed on January 9, 2009 is acknowledged. The traversal is on the ground(s) that the examiner failed to indicate the distinct species from which the election is to be made. This is not found persuasive because the requirement was for "the at least one primary alcohol", and claim 12 recites three types of primary alcohols ("a", "b", and "c").

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-14 and 16-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Collin (US Patent 6,464,967). Instant claim 12 recites a cosmetic composition comprising a poly-α-olefin produced by a dehydrating polymerization of at least one primary alcohol. Collin discloses a wax-in-water emulsion cosmetic composition that comprises at least one polyolefin wax resulting from the polymerization of α-olefins (abstract, lines 1-7). The material used by

Collin et al. in one example, PERFORMA V 260[1], is a poly-α-olefin prepared from linear α-olefins, branched α-olefins (3-methyl decene-1), and α-olefins with a vinylidene structure (column 6, example 1). Collin does not disclose a cosmetic composition that includes a poly-α-olefin made from a primary alcohol, as recited in the instant claim. Rather, the instant claim recites preparing the poly-α-olefin via a dehydrating polymerization of primary alcohols such as branched monofunctional alcohols under acidic conditions. The branched monofunctional primary alcohol monomers have no other recited functional groups present, and the resultant poly-α-olefin product would not have the alcohol functional group present (the reaction is a dehydration reaction). Thus, the material disclosed by Collin, a poly-α-olefin wherein the monomers are derived α-olefins, reads on the poly-α-olefin product instantly recited (primary alcohols reacting to form a polymer wherein the monomers could have been α-olefins). And as the patentability of a product does not depend on the method of production, but rather on the product itself (in this case, the poly-α-olefin product), the composition disclosed by Collin anticipates the composition recited in instant claim 12. See MPEP 2113.

Instant claims 13-14, 16, and 23-24 recite further limitations to the primary alcohol used to produce the poly-α-olefin, and are read on by the poly-α-olefin used by Collin (3-methyl decene-1 has 11 carbons and one methyl branch in the alkyl chain). Instant claims 17 and 25-27 recite that the poly-α-olefin is hydrogenated after the dehydrating polymerization, and as the material disclosed by Collin was prepared from monomers with only one olefin, the product disclosed by Collin will not have olefins present (the olefin reacts during polymerization), and

[1] US Patent 4,060,569 verifies that "PERFORMA V 260" is known in the art to be prepared from a mixture of α-olefins, including 3-methyl decene-1 and α-olefins having a vinylidene structure (abstract & column 3, lines 60-68).

would be unchanged by hydrogenation. Thus, the composition disclosed by Collin anticipates the compositions recited in instant claims 17 and 25-27.

The compositions disclosed by Collin further can comprise surfactants (column 5, lines 29-33). One example prepared by Collin is an emulsion that has 11.4 wt% of a polyolefin wax and 5.8 wt% of the non-ionic surfactant stearic acid (column 6, example 1). Therefore, this composition disclosed by Collin anticipates the cosmetic compositions recited in instant claims 18-22 and 28-32.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collin et al. (US Patent 6,641,821). Collin et al. discloses a cosmetic composition comprising a poly-α-olefin and a liquid fatty phase (title). The poly-α-olefin used is made from material preferably with from 27 to 52 carbons (column 2, lines 27-34). Collin et al. also discloses the inclusion of non-volatile oil in the composition (column 4, lines 4-6) such as 2-hexyldecanol (column 4, lines 38-43), which is a Guerbet alcohol. Thus, Collin et al. teaches all of the limitations of instant claim 15.

The specific combination of features claimed is disclosed within the broad genera of polyolefin waxes and non-volatile oils taught by Collin et al. but such "picking and choosing"

within several variables does not necessarily give rise to anticipation. *Corning Glass Works v. Sumitomo Elec.*, 868 F.2d 1251, 1262 (Fed. Circ. 1989). Where, as here, the reference does not provide any motivation to select this specific combination of waxes and oils, anticipation cannot be found.

That being said, however, it must be remembered that "[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious". *KSR v. Teleflex*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraida v. A.G. Pro*, 425 U.S. 273, 282 (1976)). "[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious", the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." (*Id.*). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR v. Teleflex*, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that "[a] person of ordinary skill is… a person of ordinary creativity, not an automaton." *Id.* at 1742.

Consistent with this reasoning, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have selected various combinations of polyolefin waxes and non-volatile oils from within the disclosure of Collin et al. to arrive at compositions "yielding no more than one would expect from such an arrangement".

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Gulledge whose telephone number is (571) 270-5756. The examiner can normally be reached on Monday-Thursday 6:00am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BMG

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612